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MAILED

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REEXAM UNIT

In re Application of  
Toutountzis  
Application No. 09/425,271  
Filed: October 21, 1999  
Attorney Docket No. T257.312-5

DECISION GRANTING  
PETITION UNDER  
37 CFR §1.183

This is a decision on the August 18, 2005, "Petition Under 37 CFR 1.183" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application and waiver of the 37 CFR 1.173(a)(1) requirement that a specification be furnished in the form of a copy of a printed patent, in double column format.<sup>1</sup>

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

A fee of \$400.00 has been received and processed for a petition under 37 CFR 1.183.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on June 9, 2005. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on June 9, 2005, is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

<sup>1</sup> A "Petition under 37 CFR 1.183" filed by applicant on June 9, 2005, identified the application serial number as "08/859,561." This petition was appropriately assigned to application number 08/859,561. Similarly, the petition filed on August 18, 2005, identified the application number as "08/859,561." However, the petition of August 18, 2005, was filed concurrently with a "Letter" that clearly indicated petitioner's intention to file this petition in application number 09/425,271, not 08/859,561. Accordingly, the application number on the face of the petition filed August 18, 2005, has been corrected to read "09/425,271." The petition filed on June 9, 2005 has been addressed separately in Application No. 08/859,561.

On June 9, 2005, the substitute specification was filed together with an Amendment in response to an outstanding Office action. In the Amendment, applicant states that the substitute specification was filed because the "Office Action suggested filing of a substitute specification." It is noted on page 2 of the *Ex Parte Quayle* Office action mailed March 9, 2005, the examiner stated, "[t]he examiner has repeatedly requested the filing of the substitute specification throughout the prosecution history. As such the substitute specification attached as APPENDIX A if filed with the appropriate petition under 37 CFR 1.183 will be entered."

Petitioner is requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that the Examiner has required the substitute specification. This basis is considered to be sufficient for granting the petition. The rules will be waived, since there is no other way to present the substitute specification required by the examiner, and that requirement for the substitute specification by the examiner is deemed appropriate.

#### CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on June 9, 2005, is accepted, and will be entered.
3. The reissue application file is being forwarded to Technology Center 3600 for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to Brian E. Hanlon, Office of Patent Legal Administration, at (571) 272-5047.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examining Policy

10-6-05

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